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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,877	03/31/2000	Laura M. Zanibelli	2264-0318-OX	9235

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NGUYEN, TAM M

ART UNIT	PAPER NUMBER
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1764

29

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ASL

Office Action Summary

Application No.

09/539,877

Applicant(s)

ZANIBELLI ET AL.

Examiner

Tam M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2003 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart (3,156,640) in view of Bellussi et al. (EP-340868).

Hart discloses a process for the simultaneous isomerization of olefins and hydrodesulfurization of a hydrocarbon feed mixture which has a boiling point (0 to 250° C) within the gasoline range or naphtha range by contacting the feed mixture with catalyst comprising a metal from group VI (e.g., Mo), a metal from VIII (e.g., Co), and a silica-alumina carrier comprising at least 60 wt. % of silica wherein the total metals on the catalyst is in the range of from 0.5 to 15 wt. %. Hart also discloses that the sulfur content of the sulfur-containing hydrocarbon oil fraction is in the range of from 0.05 to 0.15 wt. %. (See entire patent)

Hart does not specifically disclose that the catalyst has physical characteristics as claimed. However, Bellussi discloses a composition of a catalyst which has the same physical characteristics as the claimed catalyst (see page 1 through page 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Hart by using a catalyst which has physical characteristics as taught by Bellussi because such a catalyst is effective in a process of isomerization of olefins.

Response to Arguments

The argument that the claimed feedstock is different from the Hart feedstock since the claimed feedstock is a hydrocarbon mixture that boils within the stated range which contains from low to higher olefins contents is noted. However, the argument is not persuasive because the combined feedstock of Hart comprises hydrocarbon having a boiling range of from 0 to 250° C and olefins as claimed.

The argument that the product desired and achieved by the present process which contains isomerized olefinic material that has experienced minimal reduction to saturated isomers is distinctly from the reaction product of Hart is noted. However, the argument is not persuasive because the limitation "isomerized olefinic material that has experienced minimal reduction to saturated isomers" is not in the claims. Moreover, Hart discloses that olefins are isomerized to more highly branched olefins (see col. 4, lines 65-66).

The argument that Hart does not disclose the claimed support as claimed in claim 1 is noted. However, the argument is not persuasive because one of skill in the art would use any support (e.g., silica and/or alumina) including the claimed support which is taught by Bellussi.

The argument that the feedstock of Bellussi is different from the claimed feedstock is noted. However, the argument is not persuasive because the examiner modified the process of Hart by using the catalyst of Bellussi in the process of Hart because the Bellussi catalyst not only has equivalent function as the Hart catalyst but also is effective in a process of isomerization of olefins. The examiner does not use the Bellussi feedstock in the process of Hart.

For other arguments, please see Office Action No. 18 and 22.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tam M. Nguyen
Examiner
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TN
August 10, 2003